



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,551	02/09/2001	Thomas G. Woolston	032997-028	9095

20985 7590 02/17/2004

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

EXAMINER

THOMPSON JR, FOREST

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,551

Applicant(s)

WOOLSTON, THOMAS G.

Examiner

Forest Thompson Jr.

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16, 18-40 and 42-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16, 18-40 and 42-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendment B filed 25 February 2003 (see Paper #9) that deleted claims 17 and 41, and amended claim 27. Claims 11-16, 18-40 and 42-50 are pending in this application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (see Paper #10), or will be included here for clarity, as necessary. The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.
3. Claims 11-16, 18-40, and 42-50 have been examined.

Claim Rejections - 35 USC § 112

4. Claims 17 and 41 were objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant deleted claims 17 and 41 in amendment B. Therefore, examiner withdraws the rejection.
5. Claim 27 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant amended claim 27 in amendment B. Therefore, examiner withdraws the rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-16, 18-21, 23-40, 42-45, and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nahan et al. (U.S. Patent No. 5,664,111), in view of "Wholesale Showroom Opens to Public;" Miami Herald; FINAL Section: HOME & DESIGN, pg.6H; 21 October 1984 (hereafter referred to as Herald).

Claim 11: Nahan teaches:

- a data repository (col. 2 line 60-64);
- a first-tier (col. 2 lines 50-57; col. 7 lines 35-45);
- the inventory being offered to the first participant under a first pricing scheme (col. 13 lines 13-28; col. 15 lines 44-49); and
- a suggested retail price for customers and a net or wholesale price for dealers (col. 13 lines 13-28).

Nahan does not explicitly teach a two-tiered system, although the different prices for customers and dealers provide support for two tiers. However, Herald explicitly teaches (on pg. 1) maintaining a wholesale database, and having two prices for the items: the net dealer or business-to-business price and the retail price (equivalent to the

wholesale price and suggested retail price, respectively). This disclosure encompasses applicant's claimed aspect of the inventory is offered to the second participant (i.e., business-to-business) under a second pricing scheme different from that offered to the first participant under the first pricing scheme. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Nahan to explicitly teach a second-tier providing a second participant, different from the first participant, access to the inventory of one or more items in the data repository, the inventory being offered to the second participant under a second pricing scheme different from the first pricing scheme, as taught by Herald, for the motivation of potentially increasing sales opportunities for the businesses and encouraging return-customers

Claim 12: Nahan teaches:

- the first-tier comprises one or both of a business-to-consumer exchange and a consumer-to-consumer exchange (col. 4 lines 54-61); and
- the second-tier comprises a business-to-business exchange (col. 4 lines 54-61).

Claim 13: Nahan teaches the first-tier and the second-tier share the data repository (Abstract).

Claim 14: Nahan teaches the second participant has privileges, unavailable to the first participant, that enable the second participant to access the second-tier (col. 13 lines 13-28).

Claim 15: Nahan teaches the first-tier and second-tier are implemented on a same computer system (col. 2 lines 38-67; col. 3 lines 1-9).

Claim 16: Nahan teaches the first-tier and second-tier are implemented on separate computer systems interconnected by a network (col. 4 lines 1-6).

Claim 17: CANCELLED.

Claim 18: Nahan teaches a process that determines whether a participant is granted access to the first-tier or the second-tier (col. 7 lines 34-44).

Claim 19: Nahan teaches the process comprises a login process that grants the participant access to the second-tier if the participant has been pre-approved (col. 7 lines 34-44).

Claim 20: Nahan teaches the login process determines that the participant is pre-approved to access the second-tier if the participant enters a predetermined login ID or password or both (col. 7 lines 34-44).

Claim 21: Nahan teaches the electronic transactional system comprises an electronic catalog system (Abstract).

Claim 23: Nahan teaches the electronic transactional system comprises an electronic marketplace (col. 2 lines 50-57; col. 7 lines 35-45).

Claim 24: Nahan teaches the electronic transactional system comprises an electronic store (col. 2 lines 50-57; col. 7 lines 35-45).

Claim 25: Nahan teaches the electronic transactional system comprises an electronic vendor system (col. 4 lines 28-38).

Art Unit: 3625

Claim 26: Nahan teaches the electronic transactional system supports one or more of "sell at" offers, "buy at" offers, and counter-offers (col. 13 line 29 – col. 14 line 5).

Claim 27: Claim 27 is written as a method and contains essentially the same limitations as claim 11; therefore, the same rejection is applied.

Claims 28, 29: Nahan teaches linking the first and second transactional tiers comprises maintaining a predetermined fixed rate that determines a price differential between the first transactional tier and the second transactional tier (col. 4 lines 54-61; col. 13 lines 13-28). Nahan does not specifically teach the predetermined price differential is established by one or more dealer participants. However, Herald discloses inventory is offered to second participants (i.e., business-to-business) under a second pricing scheme (pg. 1), which encompasses offerings on an item-by-item basis at a pre-determined price differential. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Nahan to explicitly teach the predetermined price differential is established by one or more dealer participants, as taught by Herald, for the motivation of promoting sales to customers through dealers.

Claim 30: Nahan teaches linking the first and second transactional tiers comprises maintaining a price differential between the first and second tiers. **Nahan** does not specifically disclose the predetermined price differential is established by one or more dealer participants on an item-by-item basis. However, Herald discloses inventory is offered to second participants (i.e., business-to-business) under a second pricing

Art Unit: 3625

scheme (pg. 1), which encompasses offerings on an item-by-item basis. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Nahan to explicitly teach the predetermined price differential is established by one or more dealer participants on an item-by-item basis, as taught by old and well known art, for the motivation of promoting sales to customers through dealers.

Claim 31: Nahan teaches facilitating a financial transaction in the first transactional tier between a consumer participant and a dealer participant, the transaction having finality of transaction (col. 2 lines 38-45; col. 15 lines 44-49).

Claim 32: Nahan teaches facilitating a financial transaction in the second transactional tier between a first dealer participant and another dealer participant, the transaction having finality of transaction (col. 2 lines 38-45).

Claim 33: Nahan teaches facilitating a transaction in the first transactional tier between a consumer participant and a dealer participant, the transaction transferring a legally cognizable interest from the dealer participant to the consumer participant (col. 2 lines 38-45).

Claim 34: Nahan teaches facilitating a transaction in the second transactional tier between a first dealer participant and another dealer participant, the transaction transferring a legally cognizable interest from the first dealer participant to the other dealer participant (col. 2 lines 38-45).

Art Unit: 3625

Claim 35: Nahan teaches:

- receiving payment information from at least one participant in the first or second transactional tiers, the received payment information being associated with a transaction at the first or second tier (col. 13 lines 54-67; col. 14 lines 1-5);
- processing the received payment information (col. 13 lines 54-67; col. 14 lines 1-5; col. 14 lines 46-49); and
- transferring an ownership interest in an item to the at least one participant (col. 14 lines 31-46).

Claim 36: Nahan teaches:

- a first data storage location for storing information relating to an item for sale, the stored information indicating at least one of a suggested retail price term for a customer and a net or wholesale price term for a dealer (col. 2 line 60 thru col. 3 line 9; col. 5 line 49 thru col. 6 line 25; col. 13 lines 13-28; col. 15 lines 44-49);
- a second data storage location for storing a user identification identifying a participant either as a retail-tier participant or as a wholesale-tier participant (col. 2 line 60 thru col. 3 line 9; col. 5 line 49 thru col. 6 line 25); and
- a display process for selectively displaying, depending on the user identification stored in the second data storage location, at least one of the retail price term to retail-tier participants and the wholesale price term to wholesale-tier participants (col. 7 lines 35-45; col. 12 lines 52-58; col. 13 lines 13-28).

Additionally, Herald teaches (on pg. 1) maintaining a wholesale database, and having two prices for the items: the net dealer or business-to-business price and the retail price (equivalent to the wholesale price and suggested retail price, respectively). This disclosure encompasses applicant's claimed aspect of a first data storage location for storing information relating to an item for sale, the stored information indicating at least one of a retail price term for a retail-tier participant and a wholesale price term for a wholesale-tier participant, as disclosed by Herald, for the motivation of facilitating electronic commerce transactions among participants using a data packet network. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Nahan to explicitly teach a first data storage location for storing information relating to an item for sale, the stored information indicating at least one of a retail price term for a retail-tier participant and a wholesale price term for a wholesale-tier participant, as disclosed by Herald, for the motivation of facilitating electronic commerce transactions among participants using a data packet network.

Claim 37: Nahan teaches a data repository for storing information about items available for sale (col. 2 line 60-64).

Claim 38: Claim 38 is written as a system and contains essentially the same limitations as claim 13; therefore, the same rejection is applied.

Claim 39: Claim 39 is written as a system and contains essentially the same limitations as claim 15; therefore, the same rejection is applied..

Claim 40: Claim 40 is written as a system and contains essentially the same limitations as claim 16; therefore, the same rejection is applied.

Claim 41: CANCELLED

Claim 42: Claim 42 is written as a system and contains essentially the same limitations as claim 18; therefore, the same rejection is applied.

Claim 43: Claim 43 is written as a system and contains essentially the same limitations as claim 19; therefore, the same rejection is applied.

Claim 44: Claim 44 is written as a system and contains essentially the same limitations as claim 20; therefore, the same rejection is applied.

Claim 45: Claim 45 is written as a system and contains essentially the same limitations as claim 21; therefore, the same rejection is applied.

Claim 47: Claim 47 is written as a system and contains essentially the same limitations as claim 23; therefore, the same rejection is applied.

Claim 48: Claim 48 is written as a system and contains essentially the same limitations as claim 24; therefore, the same rejection is applied.

Claim 49: Claim 49 is written as a system and contains essentially the same limitations as claim 25; therefore, the same rejection is applied.

Claim 50: Claim 50 is written as a system and contains essentially the same limitations as claim 26; therefore, the same rejection is applied.

8. Claims 22 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nahan et al., and further in view of "Wholesale Showroom Opens to Public;" Miami

Art Unit: 3625

Herald; FINAL Section: HOME & DESIGN, pg.6H; 21 October 1984 (hereafter referred to as Herald) and Nitta (U.S. Patent No. 5,347,306).

Claim 22: Neither Nahan nor Herald explicitly teaches the electronic transactional system comprises an electronic auction system. However, Nahan does teach an electronic transactional system. Additionally, Nitta teaches a network-based animated electronic meeting place is provided for business meetings, education, simulated classrooms, casual encounters, personal meetings, art auctions, parties and game playing (Abstract). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teachings of Nahan to explicitly teach the electronic transactional system comprises an electronic auction system, as taught by Nitta, for the motivation of performing transactions between buyers and sellers.

Claim 46. Claim 46 is written as a system and contains essentially the same limitations as claim 22; therefore, the same rejection is applied.

Response to Arguments

9. Applicant's arguments with respect to claims 1-16, 18-40, and 42-50 have been considered but are moot in view of the new ground(s) of rejection.

Additionally, examiner has revised the rejection to more explicitly address applicant's claimed aspects. Also, salient points of the Nahan reference are identified that specifically address applicant's claimed aspects of a two-tiered system. Nahan discloses a two-tiered system in the disclosure of *Since there are generally significant*

Art Unit: 3625

advantages to a listing dealer when he can sell artwork from his own inventory to a customer in his own gallery (e.g., higher profit margin, no time delays, no shipping, etc.), the system provides the listing dealer with the ability to override reservations and sales to other dealers. (col. 15 lines 44-49)

Therefore, the rejection is maintained.

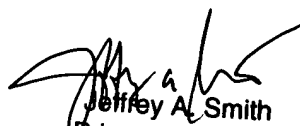
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FT
02/04/2004


Jeffrey A. Smith
Primary Examiner